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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,520	02/14/2001	Geraldine Lerebour	2365-28	7537
23117	7590	03/27/2003		

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/782,520	LEREBOUR ET AL.
	Examiner Lauren Q Wells	Art Unit 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 January 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claims 13-24 are pending. The Amendment filed 1/21/03, Paper No. 12, cancelled claims 25-31 and amended claims 13, and 21-24.

Applicant's arguments with respect to claims 13-24 have been considered but are moot in view of the new ground(s) of rejection. However, to the extent that the arguments may be relevant to the instant rejection, the Examiner will address them.

Applicant's arguments and amended filed 1/21/03, Paper No. 12, is sufficient to overcome the 35 USC 112 rejections in the previous Office Action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(j) of such treaty in the English language; (2) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 13-17, 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright (5,547,677).

Wright teaches antimicrobial oil-in-water emulsions for topical application to the skin.

Disclosed is a composition comprising an oil, wherein the oil is selected from the group

Art Unit: 1617

consisting of soybean oil, sesame oil, olive oil, canola oil, sunflower oil, and avocado oil, which meets claims 13-17, 20-22, 25-29 and 32. See Col. 2, line 10-Col. 6, line 67; Col. 11, line 58-Col. 14, line 19.

Thus, Wright and the instant invention are directed toward a method of applying to the skin an active ingredient in a cosmetic or pharmaceutical composition comprising an effective quantity of at least one fatty substance free of carbohydrate units (soybean oil, sesame oil. . .).

Claims 13-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Harbeck (2001/0001666).

Harbeck teaches cream compositions for skin management. The compositions are disclosed for topical application to the skin for treatment of acne and fungus. Disclosed are compositions comprising sweet almond oil, apricot kernel oil, jojoba oil, and others, which meets claims 13-32. See entire document.

Thus, Harbeck and the instant invention are directed toward a method of applying to the skin an active ingredient in a cosmetic or pharmaceutical composition comprising an effective quantity of at least one fatty substance free of carbohydrate units (almond oil, apricot kernel oil. . .).

Claims 13, 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05186328.

'328 teaches nonaqueous skin washing and wiping agents having excellent sebum eliminating ability. The compositions are disclosed as comprising one or more oils selected from vegetable oils, such as olive oil or almond oil. The composition is specifically disclosed for application to the skin to combat acne vulgaris. See entire abstract.

Thus, '328 and the instant invention teach a method of applying to the skin an active ingredient in a cosmetic or pharmaceutical composition comprising an effective quantity of at least one fatty substance free of carbohydrate units (olive oil or almond oil) to combat acne.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright (5,547,677) in view of Harbeck.

The instant invention is directed toward a method of applying to the skin an active ingredient in a cosmetic or pharmaceutical composition comprising an effective quantity of at least one fatty substance free of carbohydrate units

Wright fails to teach the preferred percent weights of the active ingredients (see above disclosure).

Harbeck is disclosed as discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have to have modified the composition of Wright using the teachings of Harbeck and obtain a composition comprising 5-25% of the active ingredient because a) Harbeck and Wright both teach antimicrobial compositions for topical application to the skin comprising vegetable oils and fatty acid esters; b) Harbeck teaches the vegetable oils as comprising a range of percent weights in compositions that are topically applied to the skin. Furthermore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the oils or Wright as comprising the instant percent weights because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***Response to 35 USC 102 Arguments***

Applicant argues, “Wright discloses the use of a composition to inactivate pathogenic microorganisms. . .The method disclosed in this document refers to the use of this emulsion for its significant microbicidal activity against a wide variety of microbial and yeasts. The presently claimed invention provides a method of reducing the adhesion of microorganisms to the surface of skin and/or the mucous membranes however. There is no literal or inherent teaching of the presently claimed invention of Wright”. This argument is not persuasive. The instant claims are directed to a method of applying a composition comprising in a cosmetic or pharmaceutical composition, an effective quantity of at least one fatty substance free of carbohydrate units, having a melting point of less than 35 C and having an interfacial tension of between 6 and 27 mN/m. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are

inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently reduce the adhesion of microorganisms to the surface of the skin as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed. The Examiner respectfully points out that mechanisms of action of a given composition are not patentably distinct.

Applicant argues, regarding Harbeck, “the Examiner has not demonstrated that the passages relied upon in the cited document were contained in the parent application”. Enclosed with this response is such evidence, a copy of US Patent No. 6,193,987, which is the disclosure of Application No. 09/248,573.

Applicant argues, “Harbeck discloses an antimicrobial composition which is not required by the presently claimed method. Harbeck fails to literally or inherently teach the presently claimed method”. This argument is not persuasive. Regarding the composition, the Examiner respectfully points out the recitation of a “composition comprising” as recited in the instant claims, is open-ended and therefore does not exclude any ingredients. Again, the Examiner respectfully points out that the instant claims are directed to a method of applying a composition comprising in a cosmetic or pharmaceutical composition, an effective quantity of at least one fatty substance free of carbohydrate units, having a melting point of less than 35 C and having an

interfacial tension of between 6 and 27 mN/m. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently reduce the adhesion of microorganisms to the surface of the skin as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed. The Examiner respectfully points out that mechanisms of action of a given composition are not patentably distinct.

Applicant argues, “JP 05186328. . .does not literally or inherently disclose a method of claims 22-24 (i.e., a method to reduce the adhesion of microorganisms on the surface of the skin)”. This argument is not persuasive. Again, the Examiner respectfully points out that any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

***Response to 35 USC 103 Arguments***

Applicant argues, "Harbeck discloses antimicrobial compositions which would not have motivated one of ordinary skill in the art to have altered Wright to make the presently claimed method". This argument is not persuasive. The Examiner respectfully points out that Harbeck was relied upon to teach preferred percent weights of active ingredient oils and that both Wright and Harbeck are directed to antimicrobial compositions comprising vegetable oils. Thus, one of skill in the art would be motivated to look to Harbeck for teachings of the percent weight of vegetable oils of Wright because of the expectation of achieving a composition with enhanced anti-microbial effects. Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1617

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
March 16, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

3/19/03